

REMARKS

Interview Summary

Applicant thanks Examiner Stewart for the courtesies extended to the undersigned during the telephonic interview of January 20, 2010. The undersigned explained that US 2005/0149102 ("Radisch") is not available to preclude patentability under 35 U.S.C. § 103 because the subject matter of Radisch and the subject matter of the instant application were, at the time the claimed invention was made, owned by or subject to an obligation of assignment to the same entity, namely Scimed Life Systems, Inc., which later became Boston Scientific Scimed, Inc. The undersigned referred the Examiner to the reply filed June 22, 2009 and to 35 U.S.C. § 103(c), explaining that section 103(c) had been properly invoked in the previously filed reply. Examiner Stewart agreed that the rejections under 35 U.S.C. § 103(a) using US 2005/0149102 ("Radisch") would be withdrawn. Accordingly, Examiner Stewart has agreed to withdraw the rejections of claims 33, 36-40, and 52-57, which were all rejected under 35 U.S.C. § 103(a) using Radisch in combination with other references.

Claims 19-25

Claims 19-25 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,589,286 ("Litner"). This rejection continues to be in error for the reasons presented in the replies filed March 6, 2009 and June 22, 2009. The instant Office Action does not adequately address the previously noted deficiencies.

In particular, Litner does not disclose or suggest a "ceramic fiber is intertwined with [a] non-ceramic fiber," as recited in independent claim 19. The Office Action asserts that column 5, lines 15-26, of Litner "clearly disclosed that the tubular body can be made with fibers made of metal, ceramics or combinations of the above." Here is what the cited portion of Litner actually recites:

The tubular body and flanges of the present invention may comprise any structural material that is biocompatible and provides the necessary physical properties described herein. For example, the composition of the stent may comprise polymeric materials (both natural and synthetic), ceramic materials, composite materials, metals, metal oxides, and combinations of such materials.

Biodegradable materials are preferred. One preferred structure comprises a network of biodegradable polymeric fibers having a caliber or average diameter of about 0.3 to 0.4 mm. The network may comprises [sic] a non-woven network, woven network, knitted network or the like. Poly-l-lactic acid is a particularly suitable material for stent construction, lasting up to 2 years or more in vitro before total degradation.

Litner, col. 5, lines 15-28.

The recitation in Litner of “and combinations of such materials” does not constitute a disclosure of a ceramic fiber and a non-ceramic fiber *intertwined*. Materials do not always need to be in the form of fibers and there are other ways of combining different materials without intertwining fibers of the different materials. For example, combinations of materials can be in the form of layered composites. Accordingly, the recitation of “and combinations thereof” does not constitute a disclosure of the claimed “ceramic fiber [] intertwined with the non-ceramic fiber.”

Litner does disclose biodegradable polymer fibers in “a non-woven network, woven network, knitted network or the like,” but this disclosure is specific to only biodegradable polymer fibers. This disclosure does not indicate that the previous disclosure of different possible materials are in the form of fibers or that different materials, if combined, would be in the form of intertwined fibers of the different materials. There also is not any discussion in Litner of fibers of different materials intertwined. Accordingly, the disclosure of a woven network of biodegradable polymer fibers in a network does not constitute a disclosure of a “ceramic fiber [] intertwined with [a] non-ceramic [metal containing¹] fiber.”

Because Litner does not disclose a “ceramic fiber is intertwined with [a] non-ceramic fiber,” the rejection under 35 U.S.C. § 103(a) can only be maintained if the Office Action presents a reason for why one having ordinary skill in the art would find it obvious to modify the structures disclosed by Litner to specifically include the claimed combination of a “ceramic fiber [] intertwined with [a] non-ceramic [metal containing²] fiber.” “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some

¹ Claim 19 also recites “the second fiber being a non-ceramic fiber comprising stainless steel, a nickel-titanium alloy, or a combination thereof.”

² Claim 19 also recites “the second fiber being a non-ceramic fiber comprising stainless steel, a nickel-titanium alloy, or a combination thereof.”

articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). In this case, the Examiner has failed to provide any reason for why one having ordinary skill in the art would modify Litner to have the claimed combination of a ceramic fiber intertwined with a non-ceramic metal containing fiber. Accordingly, the rejection cannot be maintained.

The Office Action also has not provided any legally sufficient reason for why one having ordinary skill in the art would select “stainless steel, a nickel-titanium alloy, or a combination thereof” as the metal material. The first asserted reason for why it would have been obvious is “because the Applicant has not disclosed that by having a stainless steel or Nitinol provides an advantage, is used for a particular purpose, or solves a stated problem.” This is not a legally sufficient reason for supporting a conclusion of obviousness; it is a conclusory statement that cannot be used to support a conclusion of obviousness. Furthermore, the Examiner’s statement confuses the burden placed on the Applicant once the Examiner presents a *prima facie* case of obviousness with the standard placed on the Examiner for making a *prima facie* case of obviousness. See MPEP § 706.02(j). Here, the Examiner has failed to present a *prima facie* case of obviousness because the Examiner has failed to allege a reason for why one having ordinary skill in the art would make the asserted selection of “stainless steel, a nickel-titanium alloy, or a combination thereof.”

The second and newly asserted reason for why one having ordinary skill in the art would use stainless steel and/or Nitinol is because one of ordinary skill in the art “would have expected Applicant’s invention to perform equally well with the biocompatible metal of the Litner reference because it would perform equally as well.” This sentence is confusing and improper. One having ordinary skill in the art at the time of invention would not have knowledge of the instantly claimed invention and thus would not consider whether the “Applicant’s invention [performs] equally well with the biocompatible metal of the Litner reference.” This demonstrates that the Office Action is improperly asserting that one having ordinary skill in the art would know about the claimed invention and compare it to Litner to determine what changes should be made to Litner. There is no legal support for this type of rejection. Accordingly, the rejection must be withdrawn.

The Office Action also fails to specifically and independently address the dependent claims that depend from independent claim 19. In particular, Litner does not disclose the feature of dependent claims 23 and 24. Although Litner discloses that the polymer fibers can be “a non-woven network, woven network, knitted network or the like,” Litner never discloses a “ceramic fiber” knitted or woven with a “non-ceramic fiber.” Applicant requests that the Examiner specifically address and explain each rejection of each dependent claim.

Claims 33, 36,-40, and 52-57

Claims 33, 36, 39, 40 were rejected under 35 U.S.C. § 103(a) as obvious over US 2005/0149102 (“Radisch”) in view of U.S. Patent No. 4,655,777 (“Dunn”). Claims 37 and 38 were rejected under 35 U.S.C. § 103(a) as obvious over Radisch in view of Dunn and further in view of U.S. Patent No. 4,604,097 (“Graves”). Claims 52, 53, and 55 were rejected under 35 U.S.C. § 103(a) as obvious over Radisch in view of Graves. Claims 54, 56, and 57 were rejected under 35 U.S.C. § 103(a) as obvious over Radisch in view of Graves and further in view of Dunn. As stated above, the Examiner has agreed to withdraw these rejections because the Applicant has properly invoked 35 U.S.C. § 103(c) to remove Radisch as a reference available under 35 U.S.C. § 103(a). Radisch is not available to preclude patentability under 35 U.S.C. § 103 because the subject matter of Radisch and the subject matter of the instant application were, at the time the claimed invention was made, owned by or subject to an obligation of assignment to the same entity, namely Scimed Life Systems, Inc., which later became Boston Scientific Scimed, Inc.

Applicant also does not understand the statement that “[t]he Examiner is not addressing claim 33 (new limitations) and 52 because they were not examined in the previous office action.” Applicant requests that all of the pending claims be examined.

Conclusion

Accordingly, each of the pending claims 19-25, 33, 34, 36-40, and 52-57 defines patentable subject matter over the cited prior art. Furthermore, each of the pending claims is believed to be in form for allowance. As such, Applicant requests that the Examiner allow pending claims 19-25, 33, 34, 36-40, and 52-57.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Please apply the required fee of \$130 for the Petition for Extension of Time fee and any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: February 22, 2010

/Geoffrey P. Shipsides, Reg. No. 55,617/

Geoffrey P. Shipsides
Reg. No. 55,617

Fish & Richardson P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, Minnesota 55402
Telephone: (612) 335-5070
Facsimile: (877) 769-7945
60618925.doc